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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,587	08/29/2003	Pratima Bajpai	016260-9005-US002	9149
23510	7590	01/24/2005	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP ONE SOUTH PINCKNEY STREET P O BOX 1806 MADISON, WI 53701			ALVO, MARC S	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/652,587	BAJPAI ET AL	
	Examiner	Art Unit	
	Steve Alvo	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/1/03</u> . | 6) <input type="checkbox"/> Other: ____  |

The election of species requirement of November 12, 2004, is repeated and made Final. Applicant has elected the species *Phanerochaete chrysosporium* with traverse. Claims 1, 2, 4 and 11-19 read on the elected species.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over YANG (TAPPI J. pages 91-96, July 1993).

The eucalyptus wood chips, paper and pulp of YANG do not differ from the claimed wood chips, paper and pulp. Any difference would have been an obvious modification of YANG. The steps of producing the wood chips can not be given probative weight in a product claim. Any difference would have been obvious over the chips of YANG.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 11-14, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over BAECKER (U.S. 5,851,351) in view of YANG (TAPPI J. pages 91-96, July 1993).

BAECKER teaches producing paper pulp by inoculating the wood chips with *Phanerochaete chrysosporium* (column 3, lines 31-34); fermenting (e.g. incubating, column 4, lines 11-19) the wood chips to cause propagation of the fungus to preferentially degrade or modify the lignin; to aid in the subsequent pulping of the inoculated wood chips (column 3, lines 7-9) and then chemically pulping the wood (column 2, lines 52-61) wherein the *Phanerochaete chrysosporium* pretreatment reduces the amount of chemical pulping agent needed in the subsequent pulping. YANG teaches (Abstract) that hardwood eucalyptus is used to make Kraft pulp. It would have been obvious to the routineer to use the hardwood eucalyptus of YANG when making the Kraft pulp of BAECKER. BAECKER teaches that the pretreatment can be prior to pulping and bleaching (column 2, lines 55-61 and column 5, lines 1-20. It would have been obvious to bleach the fungus treated chips of BAECKER in a multistage bleaching process to further brighten the pulp as such is taught by YANG et al. See BAECKER column 2, lines 32-37 for adding the nutrient adjuvant to the chips.

Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over BAECKER (U.S. 5,851,351) in view of YANG (TAPPI J. pages 91-96, July 1993) as applied to claim 1 above, and further in view of AKHTAR (5,620,564).

AKHTAR teaches that wood chips should be at an optimum moisture content of 55-65% during inoculation to ensure better colonization of the chips with the fungal mucelia (column 4, lines 28-31). It would have been obvious to the artisan to maintain the chips of

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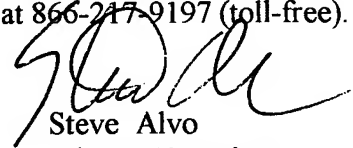
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BAECKER at a moisture content of 55-65% during fungal inoculation to ensure better colonization as taught by AKHTAR.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Alvo whose telephone number is 571-272-1185. The examiner can normally be reached on 5:45 AM - 2:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steve Alvo  
Primary Examiner  
Art Unit 1731

msa